REMARKS

Prior to entry of this Amendment:

- Claims **16, 19, 23, and 25-44** were pending in the present application
- Claims **23 and 25-27** stand rejected
- Claims **16, 19, and 28-44** are allowed

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims **16, 19, 23, and 25-44** will be pending
- Claims **16, 19, 23, and 25-26** will be the only independent claims

Interview

Applicants would like to thank the Examiner for the courtesy of the interview held on April 1, 2003, with Applicants' representative. The Examiner and Applicants' representative discussed the present application in light of the Witek reference. Applicants' representative suggested that Witek does not teach or suggest features generally directed to *a second account identifier for use in place of a first account identifier*, as recited in independent Claim **23**.

While no formal agreement was reached, Applicants are grateful for the opportunity to discuss the present application with the Examiner.

Claims 16, 19, and 28-44 Are Allowable

Applicants are grateful for the Examiner's statement that Claims 16, 19, and 28-44 contain allowable subject matter. [Office Action, page 4].

Section 103(a) Rejection

Claims **23 and 25-27** stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,253,188 issued to Witek, et al. ("Witek"). Applicants respectfully traverse the Examiner's Section 103(a) rejection.

1.   The Witek Reference

Witek is generally directed to "a computerized, interactive classified ad system and method of operation for use on the Internet, the system and method featuring simple access, rapid response, and automated updating." [Column 1, lines 5-8; see also, Abstract].

2.   Independent Claim 23

Applicants respectfully submit that independent Claim **23** is not obvious in light of Witek. Witek does not teach or suggest all of the features of independent Claim **23**. Further, there is no suggestion or motivation, either in the cited references or in the knowledge generally

available to one of ordinary skill in the art, to modify <u>Witek</u> to provide for all of the claimed features of independent Claim **23**.

2.1. <u>The References Do Not Disclose All the Limitations of Independent Claim 23</u>

As best understood by Applicants, the Examiner asserts that <u>Witek</u> discloses or suggests all of the features of independent Claim **23**, including:

(a)   *a communications unit operable to transmit and receive information regarding a second account identifier for use in place of a first account identifier*

(b)   *a memory device containing data representing a status for each of a plurality of predetermined account identifiers*

(c)   *a memory device containing a program to:*

    i.   *receive a second account identifier;*

    ii.   *compare the second account identifier with at least one of a plurality of predetermined account identifiers to identify one predetermined account identifier matching the second account identifier; and*

    iii.   *verify the second account identifier in accordance with said comparing and the data representing the status of the one predetermined account identifier*

Applicants respectfully traverse these assertions.

Some embodiments of the present invention provide for a memory device containing data indicative of a plurality of predetermined account identifiers (e.g., single-use credit card numbers). When a user (e.g., cardholder) obtains a single-use credit card number, for example, from the memory device, the status of the number is changed (e.g., from "not used" to "used"). [See, e.g., Specification, page 24, lines 8 – 24; FIG. 10]. According to some embodiments (e.g., for authorizing a transaction), when an account identifier (e.g., a single-use credit card number) is received by an entity (e.g., a credit card issuer's central processor), the entity preferably verifies the account identifier by: (i) determining whether the transmitted account identifier matches an identifier in a database (e.g., a credit card number database), and (ii) checking the status of the account identifier to determine whether the credit card number has already been used. [See, e.g., Specification, page 25, line 18 to page 26, line 3; FIG. 11A].

The Examiner asserts:

> In addition, <u>Witek</u> et al. also include a program adapted to be executed by the processing unit to receive the second account identifier, compare the second account identifier with at least one of the plurality of predetermined account identifiers to identify [sic] account identifier matching the second account identifier, and verify the second account identifier in accordance with the comparing step and the data representing [sic] status of the one predetermined account identifier (in this case is to look for a specific advertisement).

[Office Action, page 3]. Applicants respectfully traverse this brief and general assertion. As best understood by Applicants, the Examiner is asserting that the described process of the <u>Witek</u> system for searching for "a specific advertisement" teaches all of the above features. Applicants have carefully reviewed the entire <u>Witek</u> reference (including those sections pertaining to

searching for advertisements). There is nothing in <u>Witek</u> that would support the Examiner's assertion that <u>Witek</u> teaches or suggests any of the above features (a) – (c).

<u>Witek</u> describes searching for a classified ad using "ad categories" having a corresponding "category identification number," a "subcategory" having a corresponding "subcategory identification number," and "ad record identification numbers." [Column 13, lines 30 – 60]. There is no hint or suggestion, however, that such categories or identification numbers suggest *account identifiers* or that "ad records" suggest accounts; the Examiner does not assert otherwise.

Even if such categories or identification numbers suggested *account identifiers* (which Applicants dispute), there is no hint or suggestion of a *status* of such categories or numbers. Accordingly, contrary to the Examiner's assertion [Office Action, page 2] <u>Witek</u> cannot teach or suggest *data representing a status for each of said plurality of predetermined account identifiers*, as recited in independent Claim **23**.

Also, even if such categories or identification numbers suggested *account identifiers* (which Applicants dispute), there is no hint or suggestion in <u>Witek</u> of one such number being for use in place of another such number. Accordingly, contrary to the Examiner's assertion [Office Action, page 2], <u>Witek</u> cannot teach or suggest *information regarding a second account identifier for use in place of a first account identifier*, much less *a communication unit operable to receive such information*.

Further, there is no suggestion in <u>Witek</u> of *verifying an account identifier*, much less verifying an account identifier in the manner recited in independent Claim **23**. Contrary to the Examiner's assertion, therefore, <u>Witek</u> is devoid of any hint or suggestion of *verifying a second account identifier in accordance with*: (i) *comparing the second account identifier with at least one of a plurality of predetermined account identifier to identify one predetermined account identifier matching the second account identifier* and (ii) *data representing the status of the one predetermined account identifier*, as recited in independent Claim **23**. Also, <u>Witek</u> does not suggest the desirability of such features.

Applicants respectfully submit that <u>Witek</u> does not disclose all of the limitations of independent Claim **23**. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim **23**.

2.2.   **Request for Clarification**

If, on the other hand, Applicants' understanding as to what the Examiner is asserting with respect to independent Claim **23** is incorrect, Applicants request clarification of the Examiner's support in the record for each of the above features (a) – (c). Particularly, in light of the Examiner's brief and general assertion that <u>Witek</u> teaches the program recited in Claim **23**, Applicants request the Examiner's assistance in identifying the specific disclosure in <u>Witek</u> that teaches or suggests, respectively, each of the program steps of feature (c) above, so that the present application may proceed to allowance or appeal.

2.3.   No Motivation to Modify Witek

As best understood by Applicants, the Examiner also asserts the following to be true with respect to independent Claim **23**:

(d)   It would have been obvious to modify Witek to provide for *a memory device* as recited in Claim **23** because Witek discloses databases.

[See, Office Action, page 3]. Applicants respectfully traverse this assertion.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of (d) above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of (d) above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.

Applicants have carefully reviewed the Office Action issued in the present application, as well as Witek, without finding a motivation anywhere in the record that suggests the desirability of modifying Witek in the manner proposed by the Examiner.

That Witek discloses databases does not support the Examiners' assertion that it would have been obvious to modify Witek to provide for *a memory device* containing either: (i) *data representing a status for each of said plurality of predetermined account identifiers*; or (ii) *verifying a second account identifier in accordance with*: (i) *comparing the second account identifier with at least one of a plurality of predetermined account identifier to identify one predetermined account identifier matching the second account identifier* and (ii) *data representing the status of the one predetermined account identifier*, as recited in independent Claim **23**.

Further, the motivation of (d), as asserted by the Examiner, would not suggest the desirability of modifying the classified advertisement searching system of Witek to provide specifically for the claimed *memory device*. The Examiner does not provide any reasoning or support in the evidence of record as to why the mere disclosure in Witek of "databases" would specifically suggest to one of ordinary skill in the art the desirability of provide for a memory device as claimed in independent Claim **23**.

Applicants respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of independent Claim **23**. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim **23**.

For at least the reasons stated herein, Applicants respectfully request allowance of Claim **23**.

3. Independent Claim 25

The Examiner rejects independent Claim **25** on the same basis as independent Claim **23**. Applicants respectfully submit that independent Claim **25** contains allowable subject matter for at least the reasons stated above with respect to independent Claim **23**. For instance, Witek is devoid of a hint or suggestion of any features generally directed to:

(e) *a memory device containing data representing a status for each of a plurality of predetermined account identifiers*

(f) *receiving a second account identifier for use in place of a first account identifier*

(g) *comparing the second account identifier with said plurality of predetermined account identifiers to identify one predetermined account identifier matching said second account identifier*

(h) *verifying said second account identifier in accordance with said comparing step and the data representing the status of said one predetermined account identifier*

If Applicants' understanding as to what the Examiner is asserting with respect to independent Claim **25** is incorrect, Applicants request clarification of the Examiner's support in the record for each of the above features (e) – (h). Particularly, in light of the Examiner's brief and general assertion that Witek teaches all of the features of the program recited in Claim **23**, Applicants request the Examiner's assistance in identifying the specific disclosure in Witek that teaches or suggests, respectively, each of the steps of (g) – (h), so that the present application may proceed to allowance or appeal.

4. Independent Claim 26

Applicants respectfully submit that independent Claim **26** is not obvious in light of Witek. Witek does not teach or suggest all of the features of independent Claim **26**.

4.1. The References Do Not Disclose All the Limitations of Independent Claim 26

As best understood by Applicants, the Examiner asserts that Witek discloses or suggests all of the features of independent Claim **26**, including:

(i) *receiving a plurality of second account identifiers at a memory device, each second account identifier being different from remaining second account identifiers*

(j) *verifying that each of the plurality of second account identifiers indicates a first account identifier*

(k) *wherein each of the plurality of second account identifiers comprises a second identifier for use in place of a first account identifier*

Applicants respectfully traverse these assertions. The Examiner asserts that all of the above features are disclosed in Witek at Columns 12 and 13. [Office Action, page 3]. Applicants have carefully reviewed the entire Witek reference (including the cited passage). There is nothing in Witek that would support the Examiner's assertion that Witek teaches or suggests any of the above features (i) – (k).

Unfortunately, the Examiner does not state what respective aspects of the Witek system purportedly disclose each of the features (i) – (k) of Claim **26**. As discussed above with respect to independent Claim **23**, Witek describes a system for searching for classified advertisements using category and sub-category identifiers. Advertisement records are identified by "ad record identification numbers." [See, e.g., Column 12, line 49 to Column 13, line 60]. As best understood by Applicants, the Examiner is stating that this search process teaches or suggests all of features (i) – (k). Applicants respectfully submit that there is nothing in Witek, however, including the description of ad searching cited by the Examiner, that would suggest *an account identifier for use in place of another account identifier*. Moreover, there is nothing in Witek that would suggest *wherein each received second account identifier is different from remaining second account identifiers*, much less *verifying that one account identifier indicates another account identifier*, as generally recited in independent Claim **26**. Further, there is nothing in Witek that would suggest the desirability of such features.

4.2. Request for Clarification

If Applicants' understanding as to what the Examiner is asserting with respect to independent Claim **26** is incorrect, Applicants request clarification of the Examiner's support in the record for each of the above features (i) – (k). Particularly, Applicants request the Examiner's assistance in identifying the specific disclosure in Witek that teaches or suggests, respectively, each of the features (i) – (k), so that the present application may proceed to allowance or appeal.

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5.   Claim 27

Claim **27** is dependent from independent Claim **26**, and is considered to be allowable for at least the reasons stated with respect to Claim **26**.

Further, Claim **27** recites a feature of *wherein the first account identifier and each second account identifier respectively comprise sixteen digits*. Applicants respectfully submit that Witek does not teach or suggest this feature, nor does Witek suggest the desirability of such a feature.

The Examiner asserts that it would have been obvious "to set an account identifier at predetermined digits [sic] according [sic] the size of the parameters defined in the database." [Office Action, pages 3 – 4]. Applicants respectfully traverse this assertion. Applicants respectfully traverse any implication that Witek teaches "parameters" of sixteen digits, or the desirability of an account identifier having sixteen digits. In contrast, some embodiments of the present invention use a single-use credit card number having sixteen digits for use in place of an account number, such that the sixteen digit single-use credit card number can be recognized as a conventional credit card number. [See, e.g., Specification, page 13, lines 7 – 9].

Applicants respectfully submit that Claims **23 and 25-27** contain allowable subject matter.

Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to <u>Deposit Account No. 50-0271</u>. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to <u>Deposit Account No. 50-0271</u>.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.
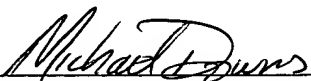
Petition for Extension of Time to Respond

Applicants hereby petition for a TWO-month extension of time with which to respond to the Office Action. Please charge $205.00 for this petition to our <u>Deposit Account No. 50-0271</u>. Please charge any additional fees that may be required for this Response, or credit any overpayment to <u>Deposit Account No. 50-0271</u>.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to <u>Deposit Account No. 50-0271</u>.

Respectfully submitted,

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Date

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